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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/380,203	04/25/2000	SUZANNE DE LA MONTE	0609.4370001	2325

7590 01/16/2004

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EXAMINER

WHITEMAN, BRIAN A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/380,203

Applicant(s)

DE LA MONTE ET AL.

Examiner

Brian Whiteman

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 15 December 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

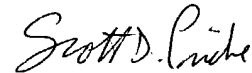
3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☒ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 39-43 and 49.Claim(s) objected to: 36 and 37.Claim(s) rejected: 1-3, 5, 6, 10-13, 35 and 44-47.Claim(s) withdrawn from consideration: None.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: The 112, first paragraph, written description rejection for claims 1, 2, 3, 5, 6, 10-13, and 35 remain for the reasons of record because applicants' arguments were fully addressed in Final Rejection filed on 9/15/03. The rejection under 112 first paragraph, enablement for claims 1, 2, 3, 5, 6, 10-13, 44-47 remain for the reasons of record because applicants' arguments were already addressed in Final Rejection mailed on 9/15/03. Furthermore, the argument that techniques for distinguishing protein degradation from decrease in protein expression are well known in the art (See Exhibits 1 and 2), is not found persuasive because the examiner already acknowledged that that at the time the application was filed, the techniques were well known. However, at the time the application was filed it, it was not well known in the art how to use the same method to observe protein degradation and a decrease in protein expression. See applicants' exhibits that teach using two different and distinct methods to determine protein degradation and a decrease in protein expression. Furthermore, the exhibits do not teach that is well known in the art to use a nucleotide sequence encoding a AD7c-NTP protein under control of a heterologous promoter in a drug screening assay. In addition, the applicants state that the working examples of the claimed method are not set forth in the specification. See page 11. For the reasons set forth above and the reasons of record, the as-filed specification fails to teach one skilled in the art how to distinguish between protein degradation and protein expression in the same method. Furthermore, the assertion that, "the initial screen for drugs that are potentially useful" indicates that one skilled in the art would not know any more about the drug than what was known before testing the drug in the claimed method.



SCOTT D. PRIEBE, PH.D
PRIMARY EXAMINER